

Attorney Docket: 622/40901RE  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7  
K. Cobb  
11/31/97

Applicant: ROMAN SCHERTLER

Serial No.: 08/530,778

Group Art Unit: 3206

Filed: SEPTEMBER 19, 1995

Examiner: KHAN V. NGUYEN

Title: A VACUUM PROCESS APPARATUS

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REQUEST FOR RECONSIDERATION

GROUP 3200

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The following is responsive to the Office Action dated June 3, 1996.

In response to the requirement for an Abstract, applicant attaches hereto on a separate sheet the Abstract from the original patent.

The objection to the reissue declaration as being defective under 37 CFR § 1.175(a)(3) is traversed, and reconsideration is requested.

In this connection, the rejection of claims 1-34 under 35 U.S.C. § 251 and the rejection of claims 30-34 under 35 U.S.C. § 251, both being based on the objection to the reissue declaration under 37 CFR 1.175(a)(3) are likewise traversed for the following reasons.

The cited rule seeks to have the applicant distinctly specify the excess or insufficiency in the claims. There is no magic formulation to how this distinct specification is to occur assuming, for arguments sake, that Rule 175 is consistent with the letter and spirit of the reissue statute.

A fair reading of the reissue declaration notes that Claims 1 and 16 were insufficient because they did not recite independent movement of the conveyors relative to the drive shaft and did contain certain specified unnecessary limitations as well as formal errors. With all due respects, applicant cannot agree that his original reissue declaration does not specify, in light of the above, how the scope of the original claims is different from the scope of the revised claims. ✓

The incomplete second sentence in the second paragraph under numbered paragraph 2 on page 3 of the Office Action cannot be understood and, more importantly, goes well beyond anything which is required to comply with Rule 175. Likewise, the last paragraph on page 3 of the Office Action adds to the requirements of Rule 175 by imposing two additional requirements, namely describing how each of the changes in the claims rectifies the errors in the original claims of the patent and how the scope of the added claims differs from the original claims of the patent. ✓

With regard to the added claims 30-34, applicant's reissue declaration distinctly specifies the original insufficiency, namely that the original patent claims did not comprehensively cover a combination of elements comprising the vacuum chamber. In particular, those claims did not define at least two holders as now set forth in claim 30, an apparatus which do not require the displacement drives to be coupled to the transport arrangement as set forth in claim 31, a linear drive for each of the conveyors as set forth in claim 32, a rotatable transport

arrangement which carries one member for holding a workpiece and a sealed displacement drive between the transport mechanism and the member as set forth in claim 33 and a processing method in connection with the vacuum chamber and at least two independently movable conveyors as set forth in claim 34.

Consequently, applicant cannot agree that the reissue declaration fails to comply with 37 CFR § 1.175(a)(3). X

Similarly, applicant traverses the objection to the reissue declaration on grounds that it allegedly fails to comply with 37 CFR § 1.175(a)(5). As noted above, applicant distinctly specified the errors in the claim coverage and how they arose or occurred. That is, the applicant pointed out that his assignee discovered the errors in claims 1 and 16 and the need for additional claims upon reviewing the patent in relation to competitive devices and a German patent publication whose relevance to the claimed subject matter was only recognized after the issuance of the original patent. Rule 175(a)(5) does not require anymore specificity with regard to how the errors arose or occurred. Certainly there is no requirement in the rules with regard to the discovery of the errors which the Examiner appears to impose as an additional requirement, over and above the Rule 175 requirement of how the errors arose or occurred. ✓

The statement that applicant's declaration does not specify why the inventions set forth in the added claims were never previously claimed in the original patent completely misses the purpose of the reissue statute which makes clear that the error


claimed by the applicant in not claiming subject matter clearly disclosed in his original patent can be corrected through reissue as long as there was no deceptive intent. It goes without saying that applicant did not claim the subject matter of claims 30-34 in his original patent because of error. That much has already been stated in his reissue declaration. Nothing more need be stated either under the reissue statute or the rules promulgated thereunder by the Patent and Trademark Office.

Accordingly, the objections to the reissue declaration and the two rejections of claims 1-34 under 35 USC § 251 are traversed, and reconsideration is requested.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #622/40901RE).

Respectfully submitted,

December 3, 1996

  
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